

Remarks

I. Introduction

This is in response to the Office Action dated March 24, 2009.

The Office Action rejected claims 1-5, 7-14, and 17-22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,912,564 to Appelman et al. ("Appelman") in view of U.S. Patent Application Publication 2002/0087646 to Hickey et al. ("Hickey"). The Office Action rejected claims 6, 15, and 16 under 35 U.S.C. §103(a) as being unpatentable over Appelman in view of Hickey and further in view of 'Official Notice'. The Office Action rejected claim 18 under 35 U.S.C. §101 stating that the claim is directed to non-statutory subject matter.

In response, Applicants have amended claims 1, 3, 14, and 16-18 and cancelled claims 13 and 15. Claims 1-12, 14, and 16-22 remain for consideration.

II. Rejections under 35 U.S.C. §101

Independent claim 18 was rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. In response Applicants have amended independent claim 18 to claim "an Internet Service Provider (ISP) configured to provide:." Independent claim 18 now claims statutory subject matter. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 18 under 35 U.S.C. §101.

III. Rejections under 35 U.S.C. §103

Independent claims 1, 3, and 18 were rejected as being unpatentable over Appelman in view of Hickey.

In order to "establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Furthermore, "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See also MPEP § 2143.03. Neither of the

cited references, either alone or in combination, teach all of the claim limitations of currently amended independent claims 1, 3 and 18. Therefore, Applicants request the withdrawal of the rejections under 35 U.S.C. §103(a).

The subject area of the present invention relates generally to digital communication and, more particularly, to email and instant messaging (see Applicants' response dated March 12, 2009 pages 2 and 3 containing a brief description). Page 13 line 25 through page 14, line 4 of the present specification indicate that a user profile may include a user type that designates whether or not the user is an administrator, a guest, or a user having limited privileges and access to email user interface 500. This aspect is recited in currently amended independent claim 3 which recites the limitation of "defining properties associated with the user IM account as a function of the user profile wherein a user type associated with the user is assigned."

This limitation was originally contained in now cancelled dependent claims 13 and 15. Dependent claim 15 depended from claim 13 and was rejected under 35 U.S.C. §103(a) as being unpatentable over Appelman in view of Hickey further in view of 'Official Notice'. In particular, the Examiner admits that Appelman and Hickey do not disclose the limitation "assigning a user type associated with the user" and relies on Official Notice to assert that this limitation is obvious. Applicants traverse the Examiner's use of Official Notice.

MPEP §2144.03(A) states that "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961))." MPEP §2144.03(b) indicates that "[t]he examiner must provide specific factual findings predicated on sound technical

and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241.”

The Office Action does not provide “specific factual findings predicated on sound technical and scientific reasoning to support [the] conclusion of common knowledge” as required for ‘Official Notice.’ The reasoning in the office action states that user types would “provide secure email communication between known and unknown users in the network.” Although assigning a user type could be used to prevent certain users from performing certain actions, the Office Action does not indicate how user types would “provide secure email communication.” Further the Office Action does not indicate how assigning a user type would “identify known and unknown users.” Thus, although the reasoning provided in the Office Action may support ‘Official Notice’ of a password or similar security measure, the reasoning does not support ‘Official Notice’ of assigning a user type. Accordingly, Applicants respectfully request withdrawal of the rejection of independent claim 3. Further, Applicants respectfully request support for the finding of ‘Official Notice’ as required under 37 C.F.R. §1.104(d)(2) if Examiner persists in using ‘Official Notice’ in the rejection of independent claim 3 under 35 U.S.C. §103(a).

For reasons discussed above, independent claim 3 cannot be rendered unpatentable under 35 U.S.C. §103(a) over Appelman in view of Hickey further in view of ‘Official Notice.’ Independent claims 1 and 18 have been amended similarly to independent claims 1. Applicants similarly traverse the Examiner’s use of Official Notice in rejecting independent claims 1 and 18 for reasons similar to those discussed above in connection with independent claim 3. As such, claims 1 and 18 also cannot be rendered unpatentable over Appelman in view of Hickey further in view of ‘Official Notice.’

For the reasons discussed above, all independent claims are allowable over the cited art. Allowance of all independent claims is requested.

All remaining dependent claims are dependent upon an allowable independent claim and are therefore also allowable. In addition, as discussed immediately below,

claim 16 contains further limitations that render the claim separately patentable over the art cited in the Office Action against this claim.

Dependent claim 16 was rejected under 35 U.S.C. §103(a) as being unpatentable over Appelman in view of Hickey further in view of 'Official Notice.' Dependent claim 16 adds the limitation "assigning a collection of IM accounts to the user." Applicants traverse the Examiner's use of Official Notice. Further, as stated in MPEP §214403, "assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art."

As shown in Figures 14, 15, and 16, a single user having multiple IM accounts can enter IM account information in a different interface for each account. As described on page 32, line 23 through page 33, line 2, the information is stored in a centralized database. Thus, a collection of IM accounts are assigned to a single user. The Office Action admits that Appelman fails to disclose "assigning a collection of IM accounts to the user" as recited in claim 16 and further indicates that "[e]xaminer takes 'Official Notice' that it was well known to one of ordinary skill in the art for assigning a collection of IM accounts to the user as it would allow a user in one IM application to communicate with other users using different IM applications without the need to install separate IM applications." However, assigning multiple IM accounts to a single user does not automatically allow that user that user to communicate with other users using different IM applications without the need to install separate IM applications.

Thus, the reasoning provided in the Office Action does not support 'Official Notice' of "assigning a collection of IM accounts to the user" as recited in claim 16. As such, the cited art, separately or in combination, fail to disclose each and every limitation of dependent claim 16. Accordingly, Applicants respectfully traverse this use of Official Notice and request withdrawal of the rejection of dependent claim 16. Further, Applicants respectfully request that if the Examiner persists in this rejection, the Examiner produce authority for this statement. (See MPEP §2144.03).

IV. No New Matter has Been Added

The amendments to claims 1, 3, 14, and 16-18 do not add new matter. Support for the amendments to claims 1, 3, and 18 may be found at least in Figures 1, 2A, and 2B, page 13, line 25 to page 14, line 4 of the specification as filed, and in claims 13 and 15 as filed. The amendments to claims 14, 16, and 17 were made to correct for the cancellation of claim 13 and do not add new matter.

V. Conclusion

For the reasons discussed above, all pending claims are allowable over the cited art. Reconsideration and allowance of all claims is respectfully requested.

Respectfully submitted,



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